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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,460	06/01/2000	Jonathan Strietzel	252/173	3051
36183	7590	06/22/2004	EXAMINER	
PAUL, HASTINGS, JANOFSKY & WALKER LLP P.O. BOX 919092 SAN DIEGO, CA 92191-9092			NGUYEN, QUYNH H	
			ART UNIT	PAPER NUMBER
			2642	
DATE MAILED: 06/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/585,460	STRIETZEL, JONATHAN	
Examiner	<b>Art Unit</b>		
Quynh H Nguyen	2642		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 April 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 13 and 30-83 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 13 and 30-83 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

2. Claim 69 is objected to because of the following informalities: A period is missing at the end of claim 69. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. Claims 30-32, 51, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregorek et al. (U.S. Patent 5,557,658).

Regarding claim 30, Gregorek teaches a marketing system for selectively modifying a portion of the processing software that permits transmitting generally continuous pre-recorded announcements. In one embodiment, the reference (at col. 19, line 49 through col. 20, line 41) teaches a method of updating ("selecting") user preferences ("customized menu selection") associated with a telecommunications advertising means ("marketing system"), comprising: a user accessing a record ("customized menu") containing the user's preferences from a database; providing the user with the option of changing or updating ("selecting") any or all preferences in the record; the user changing or updating ("selecting") some or all of the user's preferences; updating ("customizing") and storing the record in the database; and using the updated ("customized") version of the record to automatically update associations of

advertisements to be played to the user within a telecommunications network containing the telecommunications advertising means.

Regarding claim 31, Gregorek teaches the user accesses the record via a telephone ("telephone 12") or the Internet ("or other device") (col. 19, lines 28-30).

Regarding claims 32 and 51, Gregorek teaches at col. 14 lines 50-54, reads on claimed invention "the user's preferences include information related to the types of services the user is interested in or typically use".

Regarding claim 54, Gregorek teaches obtaining the user's preferences and generating ("selecting") the record ("customized menu").

***Claim Rejections - 35 USC § 103***

4. Claims 13, 33-43, 49-50, 55-59, 65-66, 69-70, 76, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent 5,557,658).

Regarding claim 13, Gregorek teaches an advertisement database (Fig. 4, 60) that stores subscriber specific ("customized menu"); and a processing mean ("message generator") configured to selectively associate, based on one or more factors selected from the group consisting of user preferences ("customized menu selection"), time of day (col. 9, lines 5-10), communication source ("the network address of the first telephone 12 or other device") and geography (col. 9, lines 17-28 and col. 19, lines 53-60), communication types (col. 6, lines 22-26), communication destination ("services provided by a particular corporation or individual" - col. 14, lines 53-54).

Gregorek does not teach associating at least one advertisement in the advertisement database with a destination of the incoming communication.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that associating the advertisement with a destination of the incoming communication is well known and the advantage of using it is also well known. For example, when one calls Macy's catalog order ("a destination of the incoming communication") he/she will receive the advertisement "associated" with Macy's sales and / or greeting of "Thank you for calling Macy's".

Regarding claims 33, 35, and 36, Gregorek teaches the processing means is configured to cause the advertisement associated with the source to replace a dial tone that would normally be routed to the source, to be routed to the source prior to connecting the source with the destination, and just prior to a dial tone being routed to the source (col. 19, lines 28-53).

Regarding claim 34, Gregorek teaches the processing means is configured to cause the advertisement associated with the source to replace the rings of a ring back signal that would normally be routed to the source (col. 8, line 61 through col. 9, line 4).

Regarding claims 37 and 58, Gregorek teaches the processing means is configured to cause the advertisement associated with the destination ("second telephone 20 or other device") when the destination goes off hook in response to the incoming communication (col. 20, lines 28-34).

Regarding claim 38, Gregorek teaches the advertisement associated with the source to be routed to the source (col. 9, lines 5-7). Furthermore, Gregorek teaches the second audible signal generator 24 is connected to a second switch 22, as is a second

message generator 26 that routes advertisement associated with the destination to the destination.

Regarding claim 39, Gregorek teaches the message generator determines the duration in which the announcements are to be played (col. 11, lines 29-31). However, Gregorek does not teach the advertisement associated with the source and the advertisement associated with the destination last the same amount of time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature mentioned above to Gregorek's system in order to stop the advertisements at the source and the destination at the same time when call processing is established.

Regarding claims 40 and 41, Gregorek teaches (Fig. 1) a switching center 15 interfaced with the source and the processing means comprises part of the switching center and a router to route the incoming call from the source 12 to the destinations 20 and 28.

Regarding claims 42, 43, and 59, Gregorek teaches the database (Fig. 2, 102) configured to store the user preferences (col. 9, lines 55-61).

Regarding claims 49 and 65, Gregorek teaches the user can access the database to update their user preferences (col. 10, lines 61-65 and col. 19, line 61 through col. 20, line 3).

Claims 50 and 66 rejected for the same reasons as discussed above with respect to claim 31.

Regarding claims 55 and 56, Gregorek does not teach the users preferences are obtained when the user signs up for a telecommunication service and obtained via a questionnaire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the mentioned above features to Gregorek's system in order to offer the user the convenience of obtaining the user's preferences while signing up for services and via a questionnaire.

Claims 57, 70, and 77 are rejected for the same reasons as discussed above with respect to claim 13. Furthermore, Gregorek teaches at least one advertisement in the advertisement database with the source of an incoming communication (col. 19, lines 53-60).

Claim 69 is rejected for the same reasons as discussed above with respect to claims 13 and 34. Obviously, central office would send the ring of the ring back signal to the source and therefore, the destination in the claim is the destination with respect to the central office.

Claims 76, and 83 are rejected for the same reasons as discussed above with respect to claims 13, 34, and 57.

5. Claims 44-48, 52, 53, 60-64, 67, 68, 71-75, and 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent 5,557,658) in view of Kung et al. (U.S. Patent 6,373,817).

Regarding claims 44-48, 52, 53, 60-64, 67, 68, 71-75, and 78-82, Gregorek teaches the users buying preferences can be of any particular subject matter (col. 14, lines 50-57). However, Gregorek does not teach the user preferences include the

user's age, salary, gender, marital and economic status, political affiliation, and number of children.

Kung et al. teach the announcement server 220 may be utilized to track the user's age, salary ("income") (col. 10, lines 13-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of the user preferences include the user's age, salary, marital status, and number of children in order to customized the advertisements accordingly.

#### ***Response to Arguments***

6. Applicant's arguments filed 7/14/03 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 13 and its dependents claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments are addressed in the above claimed rejections.

Applicant argues that regarding claim 30, Gregorek does not require direct subscriber interaction to provide a customized menu. Examiner respectfully disagrees. Gregorek teaches (col. 20, lines 1-3) that customize an individual subscriber menu based upon the previous selections or other subscriber input are direct subscriber interaction to provide a customized menu.

Applicant argues that regarding claims 44-48, 52, and 53, Kung does not disclose replacing ring tones with an advertisement is irrelevant. "Replacing ring tones with an advertisement" is not recited in the mentioned above claims.

#### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

qhn

Quynh H. Nguyen  
June 17, 2004



AHMAD F. MATAR  
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